

REMARKS

In the Final Office Action, the Examiner rejected claims 1-25. Applicant, however, respectfully asserts and maintains that these claims are patentable and in condition for allowance. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims (claims 1-25).

Rejections Under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected claims 1-25 under 35 U.S.C. § 103(a) as obvious in view of various combinations and permutations of the Tavor et al. reference (U.S. Patent No. 6,070,149; hereinafter “Tavor”), the Doi et al. reference (U.S. Patent No. 5,224,177; hereinafter “Doi”), and the Henley reference (U.S. Patent Appl. No. 2002/0065758; hereinafter “Henley”). As discussed in turn below, Applicant respectfully traverses these rejections.

Legal Precedent

First, Applicant respectfully submits that the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish a *prima facie* case of obviousness, the Examiner must satisfy two threshold burdens. First, the Examiner must show that the combination or modification includes *all* of the claimed elements. *See* M.P.E.P. § 2143.03 (Rev. 2, May 2004) (citing *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974)). Indeed, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Secondly, the Examiner must also present a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Moreover, as is firmly established by long standing legal precedent, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion *supporting* the combination or modification. *See ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir.1984). Indeed, the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless prior art also suggests the desirability of the combination. *See In re Mills*, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Thus, in presenting a Section 103 rejection, the Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *See In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). “*Broad conclusory statements standing alone are not ‘evidence’.*” *In re Kotzab*, 55 U.S.P.Q. 2d 1314, 1317 (Fed. Cir. 2000) (emphasis added).

Furthermore, when prior art references require a selected combination or modification to render obvious a subsequent invention, there must be some reason for the combination or modification *other than the hindsight* gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination or modification. *See Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Indeed, the Federal Circuit has warned that the Examiner must not “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *See In re Dembiczak* 50 U.S.P.Q. 2d 52 (Fed. Cir.1999). (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir.1983)). Moreover, avoiding hindsight reconstruction is especially important regarding less technologically complex inventions, where the very ease which the invention can be understood may prompt one to employ such hindsight. *See id.*

As discussed above, in determining the differences between the prior art and the claims, the question under Section 103 is not whether the differences themselves would

have been obvious, but whether the claimed invention as a whole would have been obvious. *See Stratoflex, Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871 (Fed. Cir. 1983). Thus, the Examiner must not look at each element of a claim individually, but rather the claims should be viewed as a tapestry comprising the recited elements. Indeed, “it is impermissible, however, to simply engage in a hindsight reconstruction of the claimed invention, *using the applicant’s structure as a template* and selecting elements from references to fill the gaps.” *In re Gorman*, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Simply put, what may seem logical to combine in retrospect and after viewing an applicant’s invention is not obvious unless the cited references, without benefit of this hindsight, teach what is claimed. *See In re Zurko*, 42 U.S.P.Q.2d 1476, 1479 (stating “[w]hile in retrospect, looking at applicants’ invention, it might seem logical to perform a repeat-back in the UNIX system over a trusted line, neither UNIX not FILER2 teaches communications with the user of a trusted pathway,” as is recited in the claim in question). In summary, a valid Section 103 rejection must *articulate and support with objective evidence* a line of reasoning that establishes why one of ordinary skill in the art, with no knowledge of an applicant’s invention, would make the combination presented in the manner claimed. *See In re Kotzab*, 55 U.S.P.Q. at 1318 (Fed. Cir. 2000).

With the foregoing legal precedent in mind, Applicant respectfully asserts that the pending claims are not obvious in view of the cited references, whether taken alone or together.

First Rejection Under Section 103

In the Final Office Action, the Examiner rejected claims 1-6 and 9-25 under 35 U.S.C. § 103(a) as obvious in view of Tavor and Doi. Specifically, in rejecting independent claims 1 and 15, the Examiner stated as follows:

A. Regarding claims 1, 12-13, 15, 17: Tavor et al. disclose a computer system coupled to a network to select a product, comprising an application server (see Tavor et al., the abstract, and Fig. 1- ref. 18), and product selector/ configuration file written in a markup language (see Tavor et al., 2:19-28 and Fig. 3), and stored in the computer system; Tavor et al. suggest questions to determine a product based on the customer's responses, a comparison program to receive a query page and compare customer's responses — by populating blanks of a web page (see Tavor et al., Fig. 4 ref. 76, and Fig. 5 ref. 44); Tavor et al. also teach about a product configuration file written in a markup language which contains information about the specific product (see Tavor et al., 2:19-28 and Fig. 3), and a server to provide a results page to the customer via the network (see Tavor et al., Fig. 1, and Fig. 4 ref. 76), the results page providing the customer with a recommended product (see Tavor et al., Fig. 4).

Taylor's [*sic*] reference fails to disclose the type of product being a radiological imaging workstation. However, Doi et al. teach a medical product such as a CR system can be purchased (col. 8:61-62).

It would have been obvious at the time the invention was made to a person of ordinary skill in the art to use a CR system as the type of product being supplied in Taylor's [*sic*] reference as disclosed in Doi since purchasing a radiological imaging workstation is a big investment, and there are many different models which a user may need a server to organize his priorities for recommendations when purchasing a proper product.

See Final Office Action mailed June 21, 2005, pp. 2-3. Additionally, in response to Applicant's previous arguments, the Examiner stated as follows:

The cited references are in the field of endeavor; such as a CR system, a MRI system; therefore, the claimed limitations of a workstation that having [*sic*] similar functions as cited systems are not an inventive

concept because the cited references teach about what the applicant claims. All languages in the pending claims have been considered/weighted and they are obvious with cited references. On page 9, 2nd para. The applicant states <<the Examiner must provide objective evidence... >>, the examiner respectfully submits that this was given in the Office Action mailed on 11/08/2004.

On page 11, 3rd para., the applicant states that <<... neither the examiner nor the cited references themselves suggest a system that establishes a relationship between a hardware component and a software component for the hardware component..." the examiner respectfully submits that this "relationship" is obviously involved in the cited systems (there is no need to spell-out because no computer-based system works without related software).

See id. at pp. 6.

Applicant, however, respectfully traverses the Examiner's rejection on the basis that the Examiner has not established a *prima facie* case of obviousness with respect to the claims. First, Applicant respectfully submits that the Examiner has not shown that the cited reference combination discloses *all* of the features recited in the pending claims. Secondly, Applicant respectfully submits that an *objectively supported* motivation for combining the cited references to reach the instant claims has not been articulated. Thirdly, Applicant respectfully submits that this lack of objective evidence demonstrates that impermissible hindsight reconstruction has been employed to reject the instant claims.

1. **The cited references fail to disclose all of the recited features.**

For example, the cited reference combination does not disclose "a query page [that] comprises a plurality of questions designed to enable the computer system to determine a recommended radiological imaging workstation ... wherein at least one of the plurality of questions establishes the *imaging software to be recommended*," as is recited

in independent claim 1. (Emphasis added.) In stark contrast, it appears that Tavor relates to a virtual sales representative for selecting *consumer products* through the use of software modules described as “intelligent.” See Tavor, col. 3, ll. 5-16; col. 16, ll. 30-37 (noting the description of various pipe lines for purchasing a screen, a VCR, or a tablecloth). As Tavor focuses on *consumer products*, it does not disclose a device or module through which an imaging device and, subsequently, a software regime for the imaging device is selected. That is, Tavor does not disclose or teach a relationship between the selected consumer product and subsequent configuration of the consumer product based upon elicited responses, let alone providing a recommended radiological imaging workstation and recommended imaging software for the radiological workstation as is recited in the pending claim. Indeed, nothing in Tavor suggests that a recommended product’s recommend configuration is determined based elicited responses; rather, Tavor only describes a technique for a recommended consumer product, with no specific configuring of the recommended product. For instance, Tavor may recommend a type of VCR, but in no way does Tavor suggest or recommend a software or operating regime for the VCR. In fact, Tavor suggests that the recommended product is based not on what is best for the consumer, but instead on what is *best for the seller*. See *id.* at col. 3, ll. 24-26 (stating that “[t]he system works to convince the user to buy certain products”).

Thus, Applicant respectfully asserts that Tavor does not disclose all of the features recited in independent claim 1 and, as such, its respective dependent claims 2-14. Therefore, Applicant respectfully submits that a *prima facie* case of obvious with respect to at least independent claim 1 and its respective dependent claims 2-14 has not been established.

**2. The cited reference combination lacks the requisite
motivation for combination.**

Even if, *arguendo*, the cited reference combination discloses all of the features recited in the pending claims, Applicant respectfully asserts that an objectively supported motivation for combination has not been articulated.

As is quoted above, the Examiner concedes that Tavor lacks a relationship to radiological imaging workstations. *See* Final Office Action mailed June 21, 2005, p. 3. However, to obviate this deficiency, the Examiner relies solely on Doi. Specifically, the Examiner relies on a single sentence in Doi that states “[t]he CR system is expensive to purchase and maintain.” *See id.* (citing Doi, col. 8, l. 62). Based on the fact that a CR system “can be purchased,” the Examiner presents the following motivation for combination: “[i]t would have been obvious at the time the invention was made to a person with ordinary skill in the art to use a CR system as the type of product being supplied in Taylor’s [*sic*] reference as disclosed in Doi since purchasing a radiological imaging workstation is a big investment, and there are many different models which a user may need to server [*sic*] to organize his priorities for recommendation when purchasing a proper product.” *See id.*

Applicant, however, respectfully submits that the Examiner has not provided *objective evidence* to support the case of obviousness presented above. Indeed, the Examiner has not cited to or presented a section of Tavor that suggests applicability to an imaging device, nor has the Examiner shown through Doi that purchasing of an imaging system through a virtual sales module of Tavor is desirable. As discussed above, the focus of Tavor appears to be consumer products. And the focus of Doi is related to “a method and *system for high quality radiographic film duplication.*” *See* Doi, col. 1, ll. 5-10 (emphasis added). Thus, Doi relates to techniques for producing the image, and not to techniques or methodology for purchasing an imaging system. Although Doi discloses that CR devices can be bought, Doi in no way suggests how or through what

methodology these devices should be purchased. Thus, neither Tavor nor Doi provide the objective evidence necessary for a *prima facie* case of obviousness.

Additionally, Applicants respectfully submit that the Examiner's reasoning in combining Tavor and Doi also lacks support with objective evidence. Indeed, the mere fact that various kinds of radiological imaging workstations— which are characterized by the Examiner as big investments— can be purchased is not sufficient to establish *why* one of ordinary skill in the art would combine Tavor and Doi to reach the specifically claimed subject matter of the present application without knowledge of Applicant's disclosure. Instead, the Examiner's rejection, at best, evidences that the cited references *can* be combined to reach the pending claims.

Moreover, Applicant respectfully submits that the Examiner's combination of these two references relies on the Examiner's *subjective belief* as to what one of ordinary skill in the art would find obvious. Regarding such a rejection, the Federal Circuit has made clear that all material facts must be documented on the record, lest the "haze of sole-called expertise" acquire insulation from accountability. *In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). In fact, common knowledge and common sense, even if assumed to derive from the agency's expertise *do not substitute for authority when the law requires authority*. *See id.* Thus, Applicant respectfully submits that this lack of *objective evidence*, which is required by Section 103, prevents the Examiner's cited reference combination from establishing a *prima facie* case of obviousness with respect to the pending claims.

3. The Examiner has employed impermissible hindsight reconstruction.

Furthermore, Applicant respectfully submits that this lack of objective evidence demonstrates that the Examiner has relied on impermissible hindsight to reach the

pending claims. Assuming that an artisan of ordinary skill in the art had no knowledge of Applicant's invention, there is no teachings in either Doi or Tavor that would lead this artisan to making the combination as is claimed in the present application. The logic provided by the Examiner– i.e., “a radiological imaging workstation is a big investment, and there are many different models which a user may need a server to organize his priorities”– relies on a retrospective analysis of Applicant's teachings, specifically the articulated benefits of the claimed subject matter. As is quoted above, case law makes clear that although it may appear logical to perform, in retrospect, a claimed technique in view of an applicant's teachings, such logic is not sufficient to establish a *prima facie* case of obviousness. See *In re Zurko*, 42 U.S.P.Q.2b 1476, 1479. With this precedent in mind, Applicant respectfully submits that the Examiner's present rejection relies wholly upon this retrospective analysis, with the simplicity of Applicant's claimed subject matter leading the Examiner down this perilous road of impermissible hindsight reconstruction.

4. Conclusion

Therefore, Applicant respectfully asserts that a *prima facie* case of obviousness with respect to the claims of the present patent application has not been established. Accordingly, Applicant respectfully submits that the pending claims of the present patent application (i.e. claims 1-25) are patentable and in condition for allowance. Respectfully, reconsideration and allowance are requested.

Second Rejection Under Section 103

In the Final Office Action, the Examiner rejected dependent claims 6-8, 14, and 19-24 under 35 U.S.C. § 103 as obvious in view of Tavor, Doi, and, additionally, Henley. Applicant, however, respectfully asserts that the addition of Henley does not obviate the deficiencies of the Tavor-Doi reference combination discussed above. Accordingly, Applicant respectfully asserts that dependent claims 6-8, 14, and 19-24 are patentable by virtue of their respective dependencies on allowable base claims, and further by the


additional features recited therein. With the foregoing in mind, Applicant respectfully requests reconsideration and allowance of dependent claims 6-8, 14, and 19-24.

Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: August 22, 2005



Manish Vyas
Reg. No. 54,516
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545